



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,885	08/17/2001	Bruno Tisserand	Q65570	5990

7590

08/02/2005

Sughrue Mion Zinn Macpeak & Seas
2100 Pennsylvania Avenue NW Suite 800
Washington, DC 20037-3213

EXAMINER

TIV, BACKHEAN

ART UNIT	PAPER NUMBER
----------	--------------

2151

DATE MAILED: 08/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,885

Applicant(s)

TISSERAND ET AL.

Examiner

Backhean Tiv

Art Unit

2151

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 3/30/05.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-16 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/01, 11/01.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

Claims 1-16 are pending in this application. This is a response to the amendment filed on 3/30/05.

Priority

Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d).

Information Disclosure Statement

The IDS filed on 8/01 and 11/01 have been considered, however, EP 1009153 was not considered because there was no English translation.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-2, 4-5, 7-8, 10-11, 13,14,16 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent 6,728,548 issued to Willhoff.

As per claim 1,8,10, a method, of sending a user message through a transmission network(Abstract), comprising: activating a request to set up a call channel(col.6, lines 37-39); placing a user message in a spare field of a signaling

message for setting up the call channel(Abstract, col.5, lines 55-65); and then performing a signaling stage comprising sending said signaling message(col.5, lines 52-55); and terminating the setting up of the call channel once a reply to the user message has been received(col.7, lines 30-33); a dedicated memory(Fig.1); the processor is adapted also to send the signaling message during a call set-up operation(col.6, lines 10-23); one or more of the user message and the reply to the user message stored in the dedicated memory(col.5, lines 3-6).

As per claim 2, 11, wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message(col.7, lines 11-15).

As per claim 4, 13, wherein: the dedicated memory is in a mobile telephone used as a modem, and the transmission network is a mobile telephone network(col.4, lines 43-65, Fig.1).

As per claim 5, 14, wherein the dedicated memory is in an ISDN type modem and an ISDN is used as the transmission network(Fig.5, col.9, lines 24-31).

As per claim 7,16, wherein the user message is communicated in an enciphered form(Fig.5, col.8, lines 54-56).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3,6,9,12,15 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 6,728,548 issued to Willhoff.

Willhoff teaches all the limitations of claims 1,8,10, however does not explicitly teach as per claim 3, 12, wherein a user is authorized to access the dedicated memory by means of specific commands.

Office Notice is taken; It is well known to one ordinary skill in the art at the time of the invention to authorize users to access protected data using commands such as userid and password or PIN(personal identification number) in order to protect data.

One ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Willhoff and to authorized access to a specific memory by means of a userid and password in order to provide a system where an unauthorized user can not access privileged data.

Willhoff teaches all the limitations of claims 1,8,10, however does not explicitly teach as per claim 6,9,15, wherein the size of the user message is limited to 35 eight-bit bytes at maximum.

Willhoff does teach however, the size of a user's message or memory can be any value according to the user's requirements(col.13, lines 10-15).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Willhoff to set a specific value of the size of the message or memory in order to save cost and/or bandwidth of sending messages.

One ordinary skill in the art would have been motivated to combine the teachings of Willhoff with setting a certain size for a user's message to reduce transmission of huge messages that the receiving mobile phone can not store.

Claims 1,2,8,10,11 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,351,235 issued to Lahtinen in view of US Patent 6,144,671 issued to Perinpanathan et al. (Perinpanathan).

As per claims 1,8,10, Lahtinen teaches a method, of sending a user message through a transmission network (Abstract), comprising: placing a user message in a spare field of a signaling message (Abstract); and then performing a signaling stage comprising sending said signaling message (Abstract, Fig.3); a dedicated memory (Figs.3-6); one or more of the user message and the reply to the user message stored in the dedicated memory (Figs.11-13).

Lahtinen however does not explicitly teach activating a request to set up a call channel; and terminating the setting up of the call channel once a reply to the user message has been received; the processor is adapted also to send the signaling message during a call set-up operation.

Perinpanathan teaches activating a request to set up a call channel (Fig.4); and terminating the setting up of the call channel once a reply to the user message has been received (col.2, lines 15-67); the processor is adapted also to send the signaling message during a call set-up operation (Figs.7-12).

Therefore it would have been obvious to one ordinary skill in the art at the time of the invention to modify the teachings of Lahtinen to set up call channels as taught by Perinpanathan in order to send SMS messages from one user to another.

One ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Lahtinen and Perinpanathan in order to provide a system to connect a user to a home address or foreign host to receive messages(col.2, lines 17-20).

As per claim 2, 11, wherein the reply to the user message is stored in a dedicated memory of the receiver of the user message(Lahtinen, Abstract).

Claims 4,5,6,7,9,13,14,15,16 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,351,235 issued to Lahtinen in view of US Patent 6,144,671 issued to Perinpanathan et al.(Perinpanathan) in further view of US Patent 6,728,548 issued to Willhoff.

Lahtinen in view of Perinpanathan teaches all the limitations of claims 1,8,10 however does not explicitly teach as per claim 4, 13, wherein: the dedicated memory is in a mobile telephone used as a modem, and the transmission network is a mobile telephone network.

Willhoff teaches the dedicated memory is in a mobile telephone used as a modem, and the transmission network is a mobile telephone network(col.4, lines 43-65, Fig.1).

Therefore it would have been obvious to one ordinary skilled in the art at the time of the invention to modify the teaching of Lahtinen in view of Perinapanathan to use a mobile telephone as modem as taught by Willhoff in order to connect to a network to receive data.

One ordinary skill in the art would have been motivated to combine the teachings of Lahtinen and Perinapanathan and Willhoff to provide a system so that a user with a mobile phone can connect to a server to access the Internet or receive messages.

As per claim 5, 14, wherein the dedicated memory is in an ISDN type modem and an ISDN is used as the transmission network(Willhoff, Fig.5, col.9, lines 24-31). Motivation to combine set forth in claim 4.

As per claim 6,9,15, wherein the size of the user message is limited to 35 eight-bit bytes at maximum(Willhoff teach the size of a user's message or memory can be any value according to the user's requirements(col.13, lines 10-15).

As per claim 7,16, wherein the user message is communicated in an enciphered form(Willhoff, Fig.5, col.8, lines 54-56). Motivation to combine set forth in claim 4.

Claims 3,12 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent 5,351,235 issued to Lahtinen in view of US Patent 6,144,671 issued to Perinapanathan et al.(Perinapanathan) in further view of US Patent 6,728,548 issued to Willhoff.

Lahtinen in view of Perinpananthan in further view Willhoff teaches all the limitations of claims 1,8,10, however does not explicitly teach as per claim 3, 12, wherein a user is authorized to access the dedicated memory by means of specific commands.

Office Notice is taken; It is well known to one ordinary skill in the art at the time of the invention to authorize users to access protected data using commands such as userid and password or PIN(personal identification number) in order to protect data.

One ordinary skill in the art at the time of the invention would have been motivated to combine the teachings of Lahtinen in view of Perinpananthan in further view Willhoff to authorized access to a specific memory by means of a userid and password in order to provide a system where an unauthorized user can not access privileged data.

Response to Arguments

Applicant's arguments filed s 1-16 have been fully considered but they are not persuasive.

The applicant argues that Willhoff does not teach terminating the setting up of the call channel once the user message has been communicated. Willhoff, col.7, lines 30-33, does teach the BMI unassigns the traffic channel.

Applicant's arguments with respect to claims 1-6 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. See PTO-892.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Backhean Tiv whose telephone number is (571)272-3941. The examiner can normally be reached on 9 A.M.-12 P.M. and 1 -6 P.M. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Zarni Maung can be reached on (571) 272-3939. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

On July 15, 2005, the Central Facsimile (FAX) Number will change from 703-872-9306 to 571-273-8300.


Backhean Tiv
2151
7/22/05


ZARNI MAUNG
SUPERVISORY PATENT EXAMINER